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**OFFICE OF PETITIONS**

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In re Patent No. 7, 524,967	:	
Koyakumar, et al.	:	ON RECONSIDERATION OF
Issue Date: April, 28 2009	:	PATENT TERM ADJUSTMENT
Application No. 10/521,800	:	UNDER 37 CFR 1.705(d)
Filing or 371(c) Date: August 2, 2005	:	
Attorney Docket No. 264837US0XPCT	:	

This is a decision on the "PETITION UNDER 37 C.F.R. § 1.705(d) AND REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT," filed June 22, 2009, requesting that the patent term adjustment determination for the above-identified patent be changed from 627 days to 896 days. This matter is properly treated as an application for patent term adjustment pursuant to 37 C.F.R. § 1.705(d).

The request for reconsideration is granted to the extent that the determination has been reconsidered; however, the request for reconsideration of patent term adjustment is **DISMISSED** with respect to making any change in the patent term adjustment determination under 35 USC 154(b) of 627 days.

On April 28, 2009, the above-identified application matured into U.S. Patent No. 7, 524,967 with a patent term adjustment of 627 days.

This application for patent term adjustment was timely filed within two months of the issue date of the patent. See 37 CFR 1.705(d).

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

Patentees request recalculation of the patent term adjustment based on the decision in *Wyeth v. Dudas*, 580 F. Supp. 2d 138, 88 U.S.P.Q. 2d 1538 (D.D.C. 2008). Patentees assert that pursuant to *Wyeth*, the PTO delay under § 154(b)(1)(A) overlaps with a delay under § 154(b)(1)(B) only if the delays "occur on the same day." Patentees maintain that the period of adjustment pursuant to 37 CFR § 1.702(b), of 269 days and the period of adjustment due to examination delay, pursuant to 37 CFR § 1.702(a), of 627 days do not overlap as these periods do not occur on the same day.

Patentees argue that the period of adjustment due to the Three Year Delay by the Office, pursuant to 37 CFR § 1.702(b), is 269 days. Patentees calculate this period as the number of days in the period beginning on the day after the date that is three years after the date on which the national stage commenced under 35 USC 371(c) in an international application, August 2, 2005, and ending on the date that the patent issued, April 28, 2009.

Patentees assert that in addition to the three year delay period, they are entitled to a period of adjustment due to examination delay, pursuant to 37 CFR § 1.702(a)(1) of 627 days for failure by the Office to mail at least one of a notification under 35 USC 132 not later than 14 months after the date the application fulfilled the requirements of 35 USC 371.

Thus, patentees assert entitlement to an adjustment of 896 days (627 days of delay pursuant to 37 CFR 1.702(a) *plus* 269 days of delay pursuant to 37 CFR 1.702(b) *less* zero overlapping days *less* zero days of applicant delay).

Under 37 CFR 1.703(f), patentees are entitled to a period of patent term adjustment equal to the period of delays based on the grounds set forth in 37 CFR 1.702 reduced by the period of time equal to the period of time during which patentees failed to engage in reasonable efforts to conclude prosecution pursuant to 37 CFR 1.704. In other words, patentees are entitled to the period of Office delay reduced by the period of applicant delay.

A review of the record reveals that Patentee's have incorrectly calculated the period of adjustment under 35 U.S.C. 154(b)(1)(B) and 37 CFR 1.702(b) for failing to issue the patent within three years of the 'actual filing date' of the application. The period of adjustment under 35 U.S.C. 154(b)(1)(B) and 37 CFR 1.702(b) is the number of days in the period beginning on the day after the date that is three years after the date on which the national stage commenced under 35 U.S.C. 371(b) or (f). See, MPEP § 2730. The commencement date is the date 30 months from the earliest priority date claimed in the international application<sup>1</sup>. In this application, the earliest priority date claimed, as shown on the Notice of Acceptance of Application Under 35 U.S.C. § 371 and 37 CFR 1.495, mailed July 19, 2005, is July 23, 2002. Accordingly, the commencement date is January 23, 2005, and the period of adjustment pursuant to 37 CFR 1.703(b) began January 24, 2008, the day after the date that is three years after the date on which the national stage commenced under 35 U.S.C. 371(b), and ended April 28, 2009, the date that the patent issued, or 461 days.

The Office asserts that as of the time of issuance of the patent, the application was pending three years and 461 days. The Office asserts that certain action was not taken within the specified time frame, and thus, the entry of a period of adjustment of 627 days is correct. At issue is whether patentees should accrue an additional 461 days of patent term adjustment for the Office taking in

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<sup>1</sup> The commencement date may be earlier than 30 months where (1) an applicant expressly requested early commencement, and completed all requirements under 35 U.S.C. 371(c) prior to 30 months from the earliest priority date, or (2) Demand was timely filed requesting a change in commencement from 20 to 30 months. Neither is applicable here.

excess of three years to issue the patent, as well as 627 days for Office failure to take a certain action within a specified time frame (or examination delay).

The Office contends that the period of 461 days of adjustment pursuant to 37 CFR 1.702(b) overlaps with the period of adjustment of 627 days pursuant to 37 CFR 1.702(a). Patentees' calculation of the period of overlap is inconsistent with the Office's interpretation of this provision. 35 U.S.C. 154(b)(2)(A) limits the adjustment of patent term, as follows:

To the extent that the periods of delay attributable to grounds specified in paragraph (1) overlap, the period of any adjustment granted under this subsection shall not exceed the actual number of days the issuance of the patent was delayed.

Likewise, 35 CFR 1.703(f) provides that:

To the extent that periods of delay attributable to the grounds specified in § 1.702 overlap, the period of adjustment granted under this section shall not exceed the actual number of days the issuance of the patent was delayed.

As explained in *Explanation of 37 CFR 1.703(f) and of the United States Patent and Trademark Office Interpretation of 35 U.S.C. 154(b)(2)(A)*, 69 Fed. Reg. 34283 (June 21, 2004), the Office interprets 35 U.S.C. 154(b)(2)(A) as permitting either patent term adjustment under 35 U.S.C. 154(b)(1)(A)(i)-(iv), or patent term adjustment under 35 U.S.C. 154(b)(1)(B), but not as permitting patent term adjustment under both 35 U.S.C. 154(b)(1)(A)(i)-(iv) and 154(b)(1)(B). Accordingly, the Office implements the overlap provision as follows:

If an application is entitled to an adjustment under 35 U.S.C. 154(b)(1)(B), the entire period during which the application was pending (except for periods excluded under 35 U.S.C. 154(b)(1)(B)(i)-(iii)), and not just the period beginning three years after the actual filing date of the application, is the period of delay under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay overlap under 35 U.S.C. 154(b)(2)(A). Thus, any days of delay for Office issuance of the patent more than 3 years after the filing date of the application, which overlap with the days of patent term adjustment accorded prior to the issuance of the patent will not result in any additional patent term adjustment. See 35 U.S.C. 154(b)(1)(B), 35 U.S.C. 154(b)(2)(A), and 37 CFR § 1.703(f). See *Changes to Implement Patent Term Adjustment Under Twenty Year Term; Final Rule*, 65 Fed. Reg. 56366 (Sept. 18, 2000). See also *Revision of Patent Term Extension and Patent Term Adjustment Provisions; Final Rule*, 69 Fed. Reg. 21704 (April 22, 2004), 1282 Off. Gaz. Pat. Office 100 (May 18, 2004). See also *Explanation of 37 CFR 1.703(f) and of the United States Patent and Trademark Office Interpretation of 35 U.S.C. 154(b)(2)(A)*, 69 Fed. Reg. 34283 (June 21, 2004).

The current wording of § 1.703(f) was revised in response to the misinterpretation of this provision by a number of Patentees. The rule was slightly revised to more closely track the corresponding language of 35 U.S.C. 154(b)(2)(A). The relevant portion differs only to the

extent that the statute refers back to provisions of the statute whereas the rule refers back to sections of the rule. This was not a substantive change to the rule nor did it reflect a change of the Office's interpretation of 35 U.S.C. 154(b)(2)(A). As stated in the *Explanation of 37 CFR 1.703(f) and of the United States Patent and Trademark Office Interpretation of 35 U.S.C. 154(b)(2)(A)*, the Office has consistently taken the position that if an application is entitled to an adjustment under the three-year pendency provision of 35 U.S.C. 154(b)(1)(B), the entire period during which the application was pending before the Office (except for periods excluded under 35 U.S.C. 154(b)(1)(B)(i)-(iii)), and not just the period beginning three years after the actual filing date of the application, is the relevant period under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay "overlap" under 35 U.S.C. 154(b)(2)(A).

This interpretation is consistent with the statute. Taken together the statute and rule provide that to the extent that periods of delay attributable to grounds specified in 35 U.S.C. 154(b)(1) and in corresponding § 1.702 overlap, the period of adjustment granted shall not exceed the actual number of days the issuance of the patent was delayed. The grounds specified in these sections cover the A) guarantee of prompt Patent and Trademark Office responses, B) guarantee of no more than 3-year application pendency, and C) guarantee or adjustments for delays due to interference, secrecy orders and appeals. A section by section analysis of 35 U.S.C. 154(b)(2)(A) specifically provides that:

Section 4402 imposes limitations on restoration of term. In general, pursuant to [35 U.S.C.] 154(b)(2)(A)-(C), total adjustments granted for restorations under [35 U.S.C. 154(b)(1)] are reduced as follows: (1) To the extent that there are multiple grounds for extending the term of a patent that may exist simultaneously (e.g., delay due to a secrecy order under [35 U.S.C.] 181 and administrative delay under [35 U.S.C.] 154(b)(1)(A)), the term should not be extended for each ground of delay but only for the actual number of days that the issuance of a patent was delayed; See 145 Cong. Rec. S14,718<sup>2</sup>

As such, the period for over three-year pendency does not overlap only to the extent that the actual dates in the period beginning three years after the date on which the application was filed overlap with the actual dates in the periods for failure of the Office to take action within specified time frames. In other words, consideration of the overlap does not begin three years after the commencement date of the application.

In this instance, the relevant period under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay "overlap" under 35 U.S.C. 154(b)(2)(A) is the entire period during which the application was pending before the Office, August 2, 2005, to the date the patent issued, April 28, 2009. Prior to the issuance of the patent, 627 days of patent term adjustment were accorded for the Office failing to respond within a specified time frame during the pendency of the application. All of the 461 days for Office delay in issuing the patent overlap with the 627 days

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<sup>2</sup> The AIPA is title IV of the Intellectual Property and Communications Omnibus Reform Act of 1999 (S. 1948), which was incorporated and enacted as law as part of Pub. L. 106-113. The Conference Report for H.R. 3194, 106<sup>th</sup> Cong. 1<sup>st</sup> Sess. (1999), which resulted in Pub. L. 106-113, does not contain any discussion (other than the incorporated language) of S. 1948. A section-by-section analysis of S. 1948, however, was printed in the Congressional Record at the request of Senator Lott, See 145 Cong. Rec. S14,708-26 (1999)(daily ed. Nov. 17, 1999).

of examination delay. During that time, the issuance of the patent was delayed by 627 days, not 627 days and 461 days. The Office took 14 months and 627 days to issue a first Office action. Otherwise, the Office took all actions set forth in 37 CFR 1.702(a) within the prescribed timeframes. Nonetheless, given the initial 627 days of Office delay and the time allowed within the timeframes for processing and examination, the patent issued three years and 461 days after its commencement date. However, the Office did not delay 627 days and also delay an additional 461 days. Accordingly, 627 days of patent term adjustment was properly entered since the period of delay of 461 days attributable to the delay in the issuance of the patent overlaps with the adjustment of 627 days attributable to grounds specified in § 1.702(a). Entry of both periods is not warranted given the entire 461 days overlapped.

In view thereof, no adjustment to the patent term will be made.

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

Telephone inquiries specific to this matter should be directed to Senior Petitions Attorney Shirene Willis Brantley, at (571) 272-3230.

A handwritten signature in black ink, appearing to read 'Alesia Brown', is written over the printed name.

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